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| 10/736,631 | 12/17/2003 | Hiroaki Imai | 500.433-40X00 | 3845 |
| 20457 7590 12/24/2008 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873 | | | | |
| EXAMINER | | | | |
| AMSDOLL, DANA | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/736,631

Applicant(s)

IMAI ET AL.

Examiner

DANA AMSDELL

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

This is a **Final** Office action acknowledging response to Non-final Office action, dated 7/17/2008.

1. Amendments to claims 1 - 8, and 10 - 13, and the addition of claims 14 - 16, are acknowledged and have been examined as presented.

Response to Arguments

2. Rejection under 35 U.S.C. §101

Applicant's arguments filed 10/17/2008 have been fully considered but they are not persuasive.

- a. Applicant's argument regarding the 35 U.S.C. §101 rejection of claims 8 and 9, stating that "the claimed invention recites a process of providing appropriate service by a computer to a user of a repeated use of a product", fails to comply with 37 CFR 1.111(b) because the language of the claims persists in reciting not a process, but "a program for causing a computer to execute a method...". This recitation is re-enforced by the language of dependent claim 9, as it is directed to "the service providing program according to claim 8". As stated in the first Office action, a program is merely software, and it has been held that software is non-statutory (MPEP 2106.01).

b. Applicant's argument regarding the 35 U.S.C. §101 rejection of claims 8 and 9, stating that "the claimed invention provides tangible benefits for providing appropriate service by a computer to a user of a repeated use of a product", fails to comply with 37 CFR 1.111(b) because the support for the "essential characteristics of the subject matter" is missing in the language of the claims, as originally presented and amended. In response to applicant's remarks that the specification supports tangible results of applicant's invention, please take notice that the features upon which applicant relies (i.e., "...the reader/writer device 220 records the number of the repeated uses on the non-contact IC chip 312 attached to the chip-equipped vessel 310, judges a service according to the content, and provides the corresponding service to the consumer 300 (or notifies the method to receive the service)". (Specification, page 12, lines 17- 23),* are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the recitation of "provides the corresponding service" does not necessarily support the requirements of patent subject matter eligibility.

3. Rejection under 35 U.S.C. §102(b)

Applicant's arguments regarding rejection of claims 1-13 under 35 U.S.C. §102(b) have been fully considered but they are not persuasive.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Applicant asserts that Nagata fails to disclose "writing information as to the reuse in the writable storage medium that the process corresponding to the executed service content has been performed by the step of executing". However, Nagata discloses this feature in the citation of previous work in the 'Background of the Invention' (§0010). This reference also discloses the "non-contact IC chip" (having a limited storage capacity) of the Applicant's invention. Nagata embodies an IC chip with limited capacity in his disclosure as well (§0464). In so far as Nagata failing to teach the newly added limitation of claim 14, being a location other than the writable storage medium, please draw your attention to Figs. 21 (a-c) and §0522 - §0567.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claim 8 recites "a program for causing a computer to execute..." However, this is merely software, and it has been held that software without a required computer-readable medium storing the software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

6. Claim 9, although providing a "computer readable recording medium" for the program of claim 8, does not necessitate that the program be actually executed by a computer and therefore is non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagata (US 2002/0077979), here-in-after "Nagata".

9. Regarding claims 1, 7- 9, Nagata teaches providing appropriate services by a computer to a user of a repeated use of a product such as a commodity vessel or a commodity, comprising:

- receiving storage information of a writable storage medium that the computer receives from a reader/writer section which has performed reading from a writable storage medium which is attached to the product presented by the product user (Fig. 1, block 10, elms. 5, 60/61; and ¶¶0411);
- recognizing the use history of the product from the storage information acquired (Fig. 35. elm. 92);
- judging the service content by checking the use history recognized in a table where service content is defined according to the number of repeated uses of the product (Fig. 76(a), 'recycle round') ;
- executing a processing according to the service content judged and outputting the processing result to an output apparatus (Fig 76(a) and ¶¶0264; and Fig. 89, elm. 125 and ¶¶1055); and
- writing information as to reuse in the writable storage medium that the process corresponding to the executed service content has been performed by the step of executing (¶¶0010 and ¶¶0464).

10. Regarding claim 2, Nagata teaches providing services in recycling products further-comprises instructing the reader/writer section to write a use history in the writable storage medium according to a commodity or a service when the presentation

of the product by the product user is upon a commodity or service purchase accompanied by the repeated use of the product (Fig. 34, steps 30/37/38; and Fig. 78)).

11. Regarding claims 3 and 16, Nagata teaches providing services in recycling products wherein attaching the writable storage medium to the product presented upon purchase of the commodity or service when the product has no writable storage medium attached thereto; and instructing the reader/writer section to write the use history to the attached writable storage medium according to the commodity or service purchase content wherein the reader/writer section executing the read operation determines whether or not the product has the writable storage medium attached thereto(¶0297 and Fig. 33, ¶0578).

12. Regarding claim 4, Nagata teaches attaching the writable storage medium to the product presented upon purchase of the commodity or service when the product has no writable storage medium attached thereto; and instructing the reader/writer section to write the use history to the attached writable storage medium according to the commodity or service purchase content (¶0573).

13. Regarding claim 5, Nagata teaches providing the product having writable storage medium attached thereto when no product is presented by the product user upon purchase of the commodity or service; and instructing the reader/writer section to write

the use history into the writable storage medium attached to the provided product according to the commodity or service purchase content (Figs. 9(a), 10(a) and ¶0314).

14. Regarding claim 6, Nagata teaches providing the product having the writable storage medium attached thereto when no product is presented by the product user upon purchase of the commodity or service; and instructing the reader/writer section to write the use history into the writable storage medium attached to the provided product according to the commodity or service purchase content (Figs. 9(a), 10(a) and ¶0314/¶0315).

15. Regarding claim 10, Naga teaches a device for providing services to a user who is repeatedly using a vessel for containing a commodity to purchase the commodity, said device (Fig. 4), comprising: a computer section; a reader/writer section connected to the computer section and capable of reading/writing information stored in a readable/writable storage medium; and a memory section connected to the computer section and capable of storing services to the user having different contents according to a number of repeated uses of the vessel; wherein when the reader/writer section detects the readable/writable storage medium which is attached to the vessel, the computer section calculates a latest number of repeated uses of the vessel from the information in the readable/writable storage medium attached to the vessel; and the computer section decides a service to be provided to the user corresponding to the latest number of repeated uses by referencing the memory section and enables

execution of the decided service (Figs. 55 and 62; and ¶0998); and wherein the computer section writes information as to reuse in the readable/writable storage medium when the decided service has been executed (Fig. 34 and ¶0401).

16. Regarding claim 11, Nagata teaches the computer section that reads a number of repeated uses of the vessel in the past from the information in the readable/writable storage medium attached to the vessel and overwrites the latest number of repeated uses on the number of repeated uses of the past in the readable/writable storage medium (Fig 67(a) and ¶0996).

17. Regarding claim 12, Naga teaches wherein the readable/writable storage medium is embedded in a thickness of the vessel (Fig. 17(b) and ¶0452).

18. Regarding claim 13, Nagata teaches wherein the computer section executes processing to attach the readable/writable storage medium to the vessel when the reader/writer section does not detect that the readable/writable storage medium is attached to the vessel (Fig. 33, step 23).

19. Regarding claims 14 and 15, Nagata teaches wherein a table to be used in judging the service content is stored at a location other than the writable storage medium ((Fig 15, elm. 161, and Fig. 76(a), 'recycle round').

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DANA AMSDELL** whose telephone number is (571)270-5210. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627